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In re Application of: :
SAJIMA, TAKAHIRO ET AL. :
Serial No.: 10/829,341 : DECISION ON PETITION TO
Filed: April 22, 2004 : ADMIT AMENDMENT
Docket: 3673-0174PUS1 : AFTER ALLOWANCE
Title: GOLF BALL : UNDER 37 CFR 1.132

This is a decision on the petition filed December 23, 2005 to admit the February 28, 2005 amendment to the claims after the allowance of the current application.

The petition is **dismissed as moot**.

In his December 23, 2005 petition, the applicant requested reconsideration of the November 23, 2005 examiner Action not entering the February 28, 2005 amendments in the currently allowed application. In support of his petition, the applicant argues that no additional search would be required, no more than a "cursory" review would be required, and there would be no "materially added work on the part of the USPTO."

The record shows that:

- 1) On December 15, 2004 the examiner issued a Notice of Allowance for the originally submitted claims 1-3.
- 2) On February 28, 2005 the applicant submitted new dependent claims 4-10. The applicant alleged in his remarks that "no patentability issues arise and no further examination issues arise."
- 3) On November 23, 2005 the examiner issued an Action stating that "Applicant is not allowed to further prosecution by adding claims after a notice of allowance."
- 4) On December 23, 2005 the applicant filed the present petition, arguing that the amendment after allowance should be admitted.

Applicable Rules and Regulations

37 CFR 1.312 states: "No amendment may be made as a matter of right in an application after the mailing of the notice of allowance. Any amendment filed pursuant to this section must be filed before or with the payment of the issue fee, and may be entered on the recommendation of

the primary examiner, approved by the Director, without withdrawing the application from issue.”

MPEP 714.16 states in relevant part: “As to amendments . . . that add a claim, the remarks accompanying the amendment must fully and clearly state the reasons on which reliance is placed to show:

- (A) why the amendment is needed;
- (B) why the proposed amended or new claims require no additional search or examination;
- (C) why the claims are patentable; and
- (D) why they were not presented earlier.”

MPEP 714.16(I) states: “37 CFR 1.312 was never intended to provide a way for the continued prosecution of an application after it has been passed for issue. When the recommendation is against entry, a detailed statement of reasons is not necessary in support of such recommendation. The simple statement that the proposed claim is not obviously allowable and briefly the reason why is usually adequate. Where appropriate, any one of the following reasons is considered sufficient:

- (A) an additional search is required;
- (B) more than a cursory review of the record is necessary; or
- (C) the amendment would involve materially added work on the part of the Office, e.g., checking excessive editorial changes in the specification or claims.

Where claims added by amendment under 37 CFR 1.312 are all of the form of dependent claims, some of the usual reasons for non-entry are less likely to apply although questions of new matter, sufficiency of disclosure, or undue multiplicity of claims could arise.”

Analysis

The petitioner argues that the amended claims should be entered because the claims were disclosed in the original specification and the claims do not pose any burden on the USPTO for additional searches. In the remarks accompanying the amendment, the applicants stated that “since all of new claims 4-10 depended on allowed claim 1, no patentability issues arise and no further examination issues arise.” In his petition, the petitioner relies on MPEP 714.16(I) which states that inappropriate “continued prosecution” occurs when: “(A) an additional search is required; (B) more than a cursory review of the record is necessary; or (C) the amendment would involve materially added work on the part of the Office, e.g., checking excessive editorial changes in the specification or claims.” The petitioner argues that because none of the three conditions above have been met, the amended claims should be entered. Moreover, the petitioner also argues that since the new claims are dependent claims, they pose a lesser burden on the USPTO. The petitioner further argues “that the Notice of Allowance was the first Office Action, such that applicants did not have a chance to present the dependent claims 4-10 at an earlier stage in the prosecution, other than submitting these claims with the original application, after having a chance to review the position of the Patent Examiner.”

The petitioner’s argument is not persuasive. The petitioner asserts that an amendment after allowance shall be admitted as long the amendment does not introduce new matter or unduly

burden the USPTO. However, under 37 CFR 1.312, “No amendment may be made *as a matter of right* in an application after the mailing of the notice of allowance.” (*Emphasis added*). Accordingly, only upon a proper showing under MPEP 714.16 *may* an amendment after allowance be considered.

The petitioner’s reliance on MPEP 714.16(I) is misplaced. MPEP 714.16(I) merely provides a guide for examiners to determine when an amendment after allowance is “continued prosecution.” The three statements “(A) an additional search is required; (B) more than a cursory review of the record is necessary; or (C) the amendment would involve materially added work on the part of the Office, e.g., checking excessive editorial changes in the specification or claims” are a list of possible reasons for an examiner to reject an amendment after allowance. However, before the examiner must determine if the amendment is “continued prosecution” under MPEP 714.16(I), the applicant has a different burden under MPEP 714.16.

MPEP 714.16 states in relevant part: “As to amendments . . . that add a claim, the remarks accompanying the amendment must fully and clearly state the reasons on which reliance is placed to show: (A) why the amendment is needed; (B) why the proposed amended or new claims require no additional search or examination; (C) why the claims are patentable; and (D) why they were not presented earlier.”

The petitioner’s remarks filed on February 28, 2005 and the statements made in the present petition do not satisfy the requirements of MPEP 714.16. The petitioner satisfies MPEP 714.16 (B), but do not satisfy the requirements of MPEP 714.16 (A), (C), or (D).

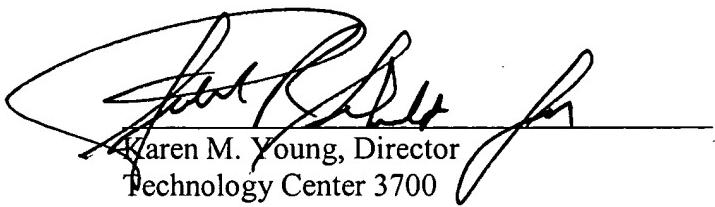
The petitioner’s response to MPEP 714.16 (A) is deficient. The petitioner does not supply any reason under MPEP 714.16 (A) for why the amendment is needed. An adequate reason under MPEP 714.16 (A) requires a showing that the application is deficient as presented and needs correction.

The petitioner’s response to MPEP 714.16 (C) is deficient. The petitioner stated in the February 28, 2005 remarks that “since all of new claims 4-10 depended on allowed claim, no patentability issues arise . . .” An adequate showing under MPEP 714.16 (C) requires each claim to be supported by the original specification, compared with each reference of record, and the patentable novelty in each claim relative to each reference to be clearly pointed out.

The petitioner’s response to MPEP 714.16 (D) is deficient. The petitioner states “that the Notice of Allowance was the first Office Action, such that applicants did not have a chance to present the dependent claims 4-10 at an earlier stage in the prosecution, other than submitting these claims with the original application, after having a chance to review the position of the Patent Examiner.” An adequate reason under MPEP 714.16 (D) requires that the petitioner make a stronger showing than merely not anticipating an allowance on the first Office Action.

The remarks and petition are deficient because they do not adequately show why the amendment is needed, why the claims are patentable, or why they were not presented earlier. Since the application has become matured in U.S. Pat. 6,986,720 on Jan. 17, 2006, then, the petition is dismissed as moot.

Any inquiry regarding this decision should be directed to Henry Yuen, Special Program Examiner, at (571) 272-4856.



Karen M. Young, Director
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